REMARKS

As a preliminary matter, the undersigned representative would like to thank Examiners Alter and Getzow for holding a personal interview at the United States Patent and Trademark Office on 5 October 2006. During the interview, claims 30-46 and the references applied in the 1 June 2006 Office Action were discussed. Agreement was reached that the pending claims distinguish over the applied references contingent upon Examiner Alter further evaluating certain references as set forth below. The applicants respectfully request that this paper also constitute the applicants' Interview Summary.

Claims 30-46 were pending on the mailing date of the outstanding Office Action (1 June 2006). Claim 30 has been amended in this paper to clarify certain aspects of this claim as discussed during the 5 October interview. Claims 30-46, therefore, are still pending in this application.

In the 1 June 2006 Office Action, all of the pending claims were rejected. More specifically, the claims were rejected on the following grounds:

(A) claim 35 was rejected under 35 U.S.C. § 112, second paragraph;

(B) claims 30-36 and 38-41 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,066,163 issued to John ("John");

(C) claims 30-46 were rejected under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2005/0021105A1 ("Firlik");

(D) claims 30-32 and 34-44 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,556,862 B2 issued to Naritoku et al. ("Naritoku"); and

(E) claims 45 and 46 were rejected under 35 U.S.C. § 102(e) over John alone or, in the alternative, under 35 U.S.C. § 103 over the combination of John and U.S. Patent No. 5,782,873 issued to Collins ("Collins").

A. Response to Section 112 Rejection

Claim 35 was rejected under 35 U.S.C. § 112, second paragraph, on the grounds that it includes an improper Markush group. Although the applicants respectfully disagree with this finding, claim 35 has been amended such that it is clearly not a Markush group. Instead, claim 35 further defines having the patient engage in a behavioral therapy by having the patient engage in at least one of a physical therapy, a cognitive therapy, an activity of daily living, a volitional use of an affected body part, a speech therapy, a visual task, a reading task, a memory task, a comprehension task, and an attention task. The applicants respectfully submit that amended claim 35 is sufficiently definite to comply with Section 112. Therefore, the applicants respectfully request withdrawal of the rejection of claim 35 under Section 112, second paragraph.

B. Response to Section 102(e) Rejection – John

Claims 30-36 and 38-31 were rejected under 35 U.S.C. § 102(e) over John. During the 5 October 2006 personal interview, agreement was reached that claim 30 distinguishes over John because John fails to disclose the combination of applying electrical stimulation to a cortical stimulation site and simultaneously having the patient engage in a behavioral therapy. This agreement is contingent upon Examiner Alter further evaluating John as set forth in the Examiner's Interview Summary. As a result, contingent upon the Examiner's further evaluation, the applicants respectfully request withdrawal of the rejection of claims 30-36 and 38-41 over John.

C. Response to Section 102(e) Rejection – Firlik

Claims 30-46 were rejected under 35 U.S.C. § 102(e) over Firlik. Firlik and the present application both claim priority to U.S. Patent Application No. 09/802,808 (the '808 Application), and both Firlik and the present application were either assigned or subject to an obligation to be assigned to Northstar Neuroscience, Inc. at the time of the present invention. During the 5 October 2006 personal interview, agreement was reached that any pending claims fully disclosed in Firlik are entitled to the filing date of the '808 Application,

and thus Firlik is not prior art to these claims. To the extent that any pending claims are not fully disclosed in Firlik and the '808 Application, Firlik is prior art only under Section 102(e) and cannot be used as the basis for an obviousness rejection under Section 103(c). To obviate any double patenting rejections over Firlik and to expedite prosecution of the present application, agreement was reached during the 5 October 2006 personal interview to file the enclosed Terminal Disclaimer regarding Firlik. Therefore, the applicants respectfully request withdrawal of this rejection over Firlik.

D. Response to Section 102(e) Rejection – Naritoku

Claims 30-32 and 34-44 were rejected under 35 U.S.C. § 102(e) over Naritoku. Agreement was reached during the 5 October 2006 personal interview that the pending claims distinguish over Naritoku because this reference discloses vagal stimulation that does not occur simultaneously while having the patient engaged in a behavioral therapy. Therefore, the applicants respectfully request withdrawal of the rejection of claims 30-32 and 34-44 over Naritoku under Section 102.

E. Response to Section 103 Rejection – John and Collins

Claims 45 and 46 were rejected under 35 U.S.C. § 102 over John alone or, in the alternative, under 35 U.S.C. § 103 over John in view of Collins. During the 5 October 2006 personal interview, agreement was reached that John teaches away from subthreshold stimulation. Additionally, it was further explained that Collins discloses stimulating sensory transducers, such as peripheral neurons associated with sensory cells. Collins accordingly fails to disclose or suggest applying electrical stimulation to a cortical stimulation site, and Collins also fails to disclose or suggest applying stimulation while applying behavioral therapy. The Examiner requested the opportunity to further consider Collins. Nonetheless, because agreement was reached that John teaches away from subthreshold stimulation, the applicants respectfully request withdrawal of the rejections of claims 45 and 46 over John under Section 102 and over the combination of John and Collins under Section 103.

In light of the foregoing, all the pending claims comply with 35 U.S.C. § 112 and are patentable over the cited art. The applicants accordingly request reconsideration of the application and respectfully submit that all the pending claims are in condition for allowance. If Examiner Alter has any questions or believes a teleconference would further expedite prosecution of this application, she is encouraged to contact the undersigned representative at (206) 359-3258.

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Respectfully submitted,

By _____

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